

REMARKS

Claims 1-19 are pending. No new matter has been added by way of the present amendment. For instance, claim 2 has been amended to remove the recitation of "hydrogen" from the definitions of R^1 to R^3 . Claims 3, 4, 6 and 8 have been amended to be in independent form. Accordingly, no new matter has been added.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 103(a)

Claim 2 is rejected under 35 U.S.C. § 103(a) as being obvious over Tesoro et al., USP 3,406,004 (hereinafter referred to as Tesoro '004), and claim 2 is rejected under 35 U.S.C. § 103(a) as being obvious over Caplus Abstract DN 78:72647 to Vali et al. (hereinafter referred to as Vali). Applicants respectfully traverse each of the rejections.

Tesoro '004 discloses a compound $CH_2=CHSO_3-CH_2-(CF_2)_9-CHF_2$ which may be polymerized to form a homopolymer. Also, Vali discloses the compound $CH_2=CHSO_3-CH_2-CF_2-CF_2-CF_3$ which can be formed into a homopolymer.

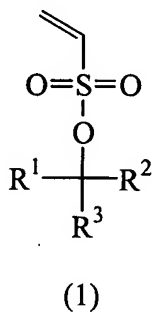
Applicants respectfully submit that present claim 2 has been amended to delete these compounds. Currently, none of R^1 to R^3 can be a hydrogen and both of these compounds have a hydrogen located on the carbon which is directly bonded to the oxygen of the SO_3 moiety.

In view of the fact that there is no overlap between inventive claim 2 and the compounds of Tesoro '004 and Vali, withdrawal of the rejections is respectfully requested.

Issues Under 35 U.S.C. § 102(e) and Double Patenting

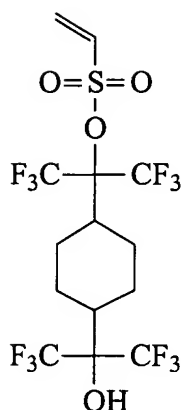
The Examiner has “provisionally” rejected claims 1, 2, 4-15 and 17-19 under 35 U.S.C. § 102(e) as being anticipated by co-pending application number 10/636,692¹ and has provisionally rejected claims 2 and 4-15 of the present application under the judicially created doctrine of obvious-type double patenting over claims 1 and 3-14 of co-pending application 10/636,692. Applicants respectfully traverse the rejections.

Applicants respectfully submit that the Examiner has misconstrued the scope of instant formulae (1) and (2). For example, formula (1) is as follows:



wherein R¹ to R³ each are fluorine or a straight, branched or cyclic alkyl or fluorinated alkyl group of 1 to 20 carbon atoms, at least one of R¹ to R³ contains fluorine, R¹ and R², R¹ and R³, or R² and R³, taken together, may form a ring, each of R¹ to R³ is a straight or branched alkylene or fluorinated alkylene group of 1 to 18 carbon atoms, preferably 1 to 10 carbon atoms, when they form a ring.

Based on the Examiner's comments on page 4 of the outstanding Office Action, it appears that the Examiner has taken the position that monomer 1 of co-pending application 10/636,692 is encompassed by formula (1). Monomer 1 has the following formula:



Monomer 1

The Examiner will note that monomer 1 differs from instant formula (1) in several respects, including the fact that monomer 1 has an OH group whereas instant formula (1) does not. Furthermore, the Examiner will note that the generic formula of co-pending application 10/636,692, which encompasses monomer 1, i.e., formulae (1-1) and (1-2) must have an -OH or -OR group bonded directly or indirectly to the 6-membered ring (see paragraphs [0008] and [0009] of its pregrant publication application No. 2004/0030079).

In view of the fact that there is no overlap between inventive formulae (1) and (2) and the compounds of co-pending application 10/636,692, withdrawal of the provisional rejections is respectfully requested.

Allowable Subject Matter

Applicants note with appreciation that the Examiner has indicated that claims 3 and 16 are allowed.


¹ Note that application 10/636,692 has been allowed and the Issue Fee was paid on July 13, 2005.

With the above remarks, Applicants believe that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq. (Reg. No. 43,575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

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Respectfully submitted,

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